

**REMARKS:**

Claims 1-35 are currently pending in the subject Application.

Claims 1-22 stand rejected under 35 U.S.C. § 101.

Claims 1-35 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,076,080 to Morscheck et al. ("*Morscheck*") in view of U.S. Patent No. 6,014,644 to Erickson ("*Erickson*").

Applicant notes with thanks the Examiner's response of 14 November 2008. Applicant further notes with thanks the Examiner's withdrawal of the previous rejections of Claims 1-35 under U.S.C. § 102 in view of *Erickson*.

Applicant respectfully submits that all of the Applicant's arguments and amendments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner's rejections. In addition, Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

**REJECTION UNDER 35 U.S.C. § 101:**

Claims 1-22 stand rejected under 35 U.S.C. § 101 as allegedly being directed towards non-statutory subject matter.

In response, Applicant has amended Applicant's claims. Applicant respectfully submits that the amendments to Applicant's claims are not necessitated by any prior art and are unrelated to the patentability of the present invention.

Thus, Applicant respectfully submits that Claims 1-22, as amended, are considered to be in full compliance with the requirements of 35 U.S.C. § 101 and respectfully requests that the rejection of Claims 1-22 under 35 U.S.C. § 101 be withdrawn.

**REJECTION UNDER 35 U.S.C. § 103:**

Claims 1-35 stand rejected under 35 U.S.C. § 103(a) over *Morscheck* in view of *Erickson*.

Applicant respectfully submits that *Erickson* fails to disclose each and every element recited by Claims 1-35. Applicant further respectfully submits that Claims 1-35 patentably distinguish over *Erickson*. Thus, Applicant respectfully traverses the Examiners rejection of Claims 1-35 under 35 U.S.C. § 102(b) over *Erickson*.

Applicant respectfully submits that the *amendments to Claims 1, 11, 23, and 35 have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims*. Applicant further respectfully submits that amended independent Claims 1, 11, 23, and 35 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Morscheck* and *Erickson*, either individually or in combination. Thus, Applicant respectfully traverse the Examiner's obvious rejection of Claims 1-35 under 35 U.S.C. § 103(a) over the proposed combination of *Morscheck* and *Erickson*, either individually or in combination.

**The Proposed *Morscheck-Erickson* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims**

For example, with respect to amended independent Claim 1, this claim recites:

An electronic commerce system for order acceleration through document reuse, the system comprising:

    a storage medium stored therein one or more document repositories each including a plurality of documents used during a first electronic commerce transaction;

    a storage medium stored therein a global content directory including a plurality of classes organized in a hierarchy, each class categorizing the documents and associated with one or more attributes of the documents categorized in the class, at least one of the classes having one or more associated pointers that identify one or more of the one or more document repositories;

a storage medium stored therein a search interface associated with the global content directory, the search interface communicates a search query to the one or more document repositories identified by one of the pointers to search the documents stored in the document repositories;

a storage medium stored therein a security module associated with the global content directory, the security module decrypts the documents to allow a user to access the documents; and

a storage medium stored therein an intelligence module associated with the global content directory, the intelligence module updates one or more sections in the documents with current information associated with a second electronic commerce transaction.

(Emphasis Added). In addition, *Morscheck* or *Erickson*, either individually or in combination, fail to disclose each and every element of independent Claims 11, 23, and 35.

Applicant respectfully submits that *Morscheck* fails to disclose “a storage medium stored therein a security module associated with the global content directory, the security module decrypts the documents to allow a user to access the documents,” as recited by independent Claim 1, as amended. For example, nowhere in *Morscheck* is there mentioned a security module nor is there any mention of decryption of a document. In fact, Applicant finds no such teaching anywhere in *Morscheck* and certainly not in the cited portions of *Morscheck*, cited by the Examiner. Furthermore, Applicant is unable to find the terms “*security module*” or “*decrypt*” anywhere in *Morscheck*, and respectfully request the Examiner to point to the portions of *Morscheck* that the Examiner is relying on.

#### **The Office Action Acknowledges that *Morscheck* Fails to Disclose Various Limitations Recited in Applicants Claims**

Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Morscheck* fails to disclose various elements recited in independent Claim 1. Specifically the Examiner acknowledges that *Morscheck* fails to disclose “a global content directory which includes a plurality of classes.” (14 November 2008 Office Action, Page 4). However, the Examiner asserts that the cited portions of *Erickson* disclose the acknowledged shortcomings in *Morscheck*. Applicants respectfully traverse the Examiner’s assertions regarding the subject matter disclosed in *Erickson*.

Applicant respectfully submits that *Erickson* fails to disclose “a storage medium stored therein a global content directory including a plurality of classes organized in a hierarchy, each class categorizing the documents and associated with one or more attributes of the documents categorized in the class, at least one of the classes having one or more associated pointers that identify one or more of the one or more document repositories,” as recited by independent Claim 1, as amended. In fact, Applicant is unable to find the terms “*global content directory*” or “*hierarchy*” anywhere in *Erickson*, and respectfully request the Examiner to point to the portions of *Erickson* that the Examiner is relying on.

**The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Morscheck-Erickson* Combination According to the UPSTO Examination Guidelines**

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Morscheck* or *Erickson*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in

any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “*ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied*.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “*factual findings made by Office personnel are the necessary underpinnings to establish obviousness*.” (*id.*). Further, “*Office personnel must provide an explanation to support an obviousness rejection* under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the *factual findings necessary to establish obviousness* or even *an explanation to support the obviousness rejection* based on the proposed combination of *Morscheck* and *Erickson*. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time of the invention was made the system, method and software of *Morscheck*, to include global content directory which includes a plurality of classes; documents comprise unique documents stored in seller database; classes comprise a plurality of document classes; the classes comprise a plurality of product classes, as taught by *Erickson*.” (14 November 2008 Office Action, Pages 4-5). Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the *factual findings necessary to establish obviousness* and is not a sufficient *explanation to support the obviousness rejection* based on the proposed combination of *Morscheck* and *Erickson*. *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including the factual findings necessary to establish obviousness to “ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “*obviousness rejection should include*, either explicitly or implicitly in view of the prior art applied, *an indication of the level of ordinary skill.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided *an indication of the level of ordinary skill. Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an indication of the level of ordinary skill, relied upon by the Examiner.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that *Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.* (*Id.*). In addition, the Guidelines state that the proper analysis is *whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.* (*Id.* and *See* 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicants invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to *explain why the difference(s) between the proposed combination of Morscheck, Erickson and Applicants claimed invention would have been obvious to one of ordinary skill in the art.* The Office Action merely states that “in order to allow easy access to the information stored.” (14 November 2008 Office Action, Pages 4-5). Applicant respectfully disagrees and further respectfully requests clarification as to how this statement *explains why the difference(s) between the proposed combination of Morscheck, Erickson and Applicants claimed invention would have been obvious to one of ordinary skill in the art.* Applicants further respectfully submit that the Examiner is using the

subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the “key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that “*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.*” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that “[R]ejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there *must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” (*KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicants respectfully submit that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicants claimed invention would have been obvious.* For example, the *Examiner has not adequately supported the selection and combination of Morscheck and Erickson to render obvious Applicants claimed invention.* The Examiner’s unsupported conclusory statements that “it would have been obvious to one of ordinary skill in the art at the time of the invention was made the system, method and software of Morscheck, to include

global content directory which includes a plurality of classes; documents comprise unique documents stored in seller database; classes comprise a plurality of document classes; the classes comprise a plurality of product classes, as taught by Erickson” and “in order to allow easy access to the information stored,” *does not adequately provide clear articulation of the reasons why Applicants claimed invention would have been obvious*. (14 November 2008 Office Action, Pages 4-5). In addition, the Examiner’s unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicants claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Morscheck* and *Erickson*, *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines*.

#### **Applicant’s Claims are Patentable over the Proposed *Morscheck-Erickson* Combination**

With respect to independent Claims 11, 23, and 35 these claims contain similar limitations and are thus, considered patentably distinguishable over the proposed combination of *Morscheck* and *Erickson* for at least the reasons discussed above in connection with independent Claim 1.

Furthermore, with respect to dependent claims 2-10, 12-22, and 24-34: Claims 2-10 depend from independent Claim 1; Claims 12-22 depend from independent Claim 11; and dependent Claims 24-34 depend from independent Claim 23 and are also considered patentably distinguishable over *Erickson*. Thus, dependent Claims 2-10, 12-22, and 24-34 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicant respectfully submits that Claims 1-35 are not rendered obvious by the proposed combination of *Morscheck* and *Erickson*. Applicant further respectfully submits that Claims 1-35 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 1-35 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-35 be allowed.



**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

15 February 2009  
Date

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